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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,837	05/23/2007	Rory McCrae Tulloch	066455-0271	3744

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DYKEMA GOSSETT PLLC  
FRANKLIN SQUARE, THIRD FLOOR WEST  
1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER
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BOMAR, THOMAS S

ART UNIT	PAPER NUMBER
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3676

MAIL DATE	DELIVERY MODE
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09/21/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,837	<b>Applicant(s)</b> TULLOCH ET AL.	
	<b>Examiner</b> Shane Bomar	<b>Art Unit</b> 3676	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-31 and 34-38 is/are rejected.
- 7) ☒ Claim(s) 32,33 and 39-49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 26-31 and 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,241,032 of Falgout.

Regarding claim 26, Falgout discloses a downhole swivel joint assembly comprising first (24) and second (20) components movable relative to one another in an axial direction along a longitudinal axis of the assembly, said components being movable relative to one another in said axial direction between a mechanically stable unactivated configuration, in which relative rotational movement between the first and second components is prevented (Fig. 4 with spear LS present), and a mechanically stable activated configuration, in which said rotational movement is permitted (with no spear LS); wherein the assembly further comprises means (23) for resisting movement of said components from the unactivated configuration to the activated configuration, said means comprising a resiliently deformable member (23a) arranged so as to be resiliently deformed when said components are moved from the mechanically stable unactivated configuration to the mechanically stable activated configuration (col. 3, line 64 - col. 4, line 23).

Regarding claim 27, the resisting means (23) resists movement of the components from the activated configuration to the unactivated configuration because spear LS is not present when the components are activated.

Regarding claim 28, the resiliently deformable member (23a) is arranged to be resiliently deformed by spear LS when the components are moved from the activated configuration to the unactivated configuration (see dashed lines in Fig. 4 to see the resilient deformation from the left to the right).

Regarding claim 29, the force needed to move the components from the unactivated configuration to the activated configuration must inherently be greater than the force necessary

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to move the components from the activated configuration to the unactivated configuration because the movement from the unactivated configuration to the activated configuration requires the spear LS to be physically retrieved and pulled up opposite to the that of the force of gravity, whereas movement from the activated configuration to the unactivated configuration is assisted by the force of gravity.

Regarding claim 30, said resiliently deformable member (23) comprises a first cam surface and is retained in a fixed axial position relative to one of said first and second components, the other one of said components being provided with a second cam surface (20d) for co-operating with the first cam surface and radially camming said member in to a resiliently deformed position when moving from the unactivated configuration (Fig. 4).

Regarding claim 31, said resiliently deformable member (23) comprises a third cam surface (23b), said other one of said components being provided with a fourth cam surface (24d) for co-operating with the third cam surface and radially camming said member in to a resiliently deformed position when moving from the activated configuration (Fig. 4).

Regarding claim 34, the first component (20) is provided with means for connecting the assembly to further downhole equipment located, in use, above the assembly; and wherein the second component (24) is provided with means for connecting the assembly to yet further downhole equipment located, in use, below the assembly (Figs. 1 and 4).

Regarding claim 35, the second component (24), or equipment connected thereto, is provided with an arm member (24e) extending outwardly for engaging, in use, with an uphole facing shoulder (20e) that is within a wellbore (Fig. 4).

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Regarding claims 36 and 37, bearings 8-10 that inherently comprise rolling elements and races are provided between the first and second components so as to assist in relative rotation between said components when said components are in the activated configuration (Figs. 1 and 4, wherein it is stated that the bottom of Fig. 1 corresponds to the bottom of Fig. 4 that is not seen).

Regarding claim 38, the bearing is located so as to be spaced from said second component (24) when said components are in the activated position (Figs. 1 and 4).

***Allowable Subject Matter***

4. Claims 32, 33, and 39-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

5. The prior art made of record on form 892 and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is (571)272-7026. The examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer H. Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shane Bomar/

Primary Examiner, Art Unit 3676